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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/811,583	03/29/2004	Jay S. Walker	03-068	2063

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WALKER DIGITAL
2 HIGH RIDGE PARK
STAMFORD, CT 06905

EXAMINER

SAGER, MARK ALAN

ART UNIT	PAPER NUMBER
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3712

DATE MAILED: 06/27/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/811,583

Applicant(s)

WALKER ET AL.

Examiner

M. A. Sager

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on IDS rec'd 4/26/04 and 3/29/04.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-37 is/are pending in the application.
- 4a) Of the above claim(s) 1-14 and 18-32 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 15-17 and 35-37 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 4/26/04, 3/29/04.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

RESTRICTION REQUIREMENT

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-5, drawn to method, classified in class 705, subclass 14.
- II. Claims 6-13, drawn to method, classified in class 705, subclass 14.
- III. Claim 14, drawn to method, classified in class 705, subclass 14.
- IV. Claims 15-17 and 33-37, drawn to method, classified in class 463, subclass 42.
- V. Claim 18-20, drawn to method, classified in class 463, subclass 25.
- VI. Claim 21-32, drawn to method, classified in class 463, subclass 25.

2. The inventions are distinct, each from the other because of the following reasons:

Inventions I-VI and VI are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct if they do not overlap in scope and are not obvious variants, and if it is shown that at least one subcombination is separately usable. In the instant case, subcombination I has separate utility such as providing/incrementing/decrementing comp points for a plurality of players that does not require the particulars of group II-VI claims, subcombination II has separate utility such as awarding comp points to an entity that is not an individual that does not require the particulars of group I or III-VI claims, subcombination III has separate utility such as receiving an indication that a tracking card is inserted, receiving an indication of a selection of a second gaming device and awarding a number of comp points to an account associated with tracking card that does not require the particulars of group I-II and IV-VI claims, subcombination IV has separate utility such as generating based on both first and second input an outcome comprising a plurality of indicia that does not require the

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particulars of group I-III and V-VI claims, subcombination V has separate utility such as transmitting instructions to second gaming device to provide entry into a bonus round that does not require the particulars of group I-IV and VI claims, subcombination VI has separate utility such as determining first and second state, instructing to display first and second state, determining final state and determining first and second compensation based on final state that does not require the particulars of group I-V claims. See MPEP § 806.05(d).

3. Because these inventions are independent or distinct for the reasons given above and have acquired a separate status in the art in view of their different classification, restriction for examination purposes as indicated is proper.

4. Because these inventions are independent or distinct for the reasons given above and the inventions require a different field of search (see MPEP § 808.02), restriction for examination purposes as indicated is proper.

5. During a telephone conversation with Mr. M. Downs (50252) on June 6, 2006 and with Ms. Magdalena Fincham (46085) on June 7, 2006 a provisional election was made without traverse to prosecute the invention of group IV, claims 15-17 and 33-37.

Affirmation of this election must be made by applicant in replying to this Office action.

Claims 1-14, 18-32 are withdrawn from further consideration by the examiner, 37

CFR 1.142(b), as being drawn to a non-elected invention.

6. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim

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remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Double Patenting

7. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the “right to exclude” granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

8. Claims 15-16 and 33-37 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-72 of U.S. Patent No. 6172872 or over claims 1-53 of U.S. Patent No. 6206782 or over claims 1-49 of U.S. Patent No. 6312332 or over claims 1-10 of U.S. Patent No. 6361441 or over claims 1-19 of U.S. Patent No. 6712699 or over claims 1-33 of U.S. Patent No. 6733390. Although the conflicting claims are not identical, they are not patentably distinct from each other because it would have been obvious to an artisan to claim the method of the gaming device or system or computer program product so as to correct the process of the invention. The claims of cited patents claim team result or outcome or totaling

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results/outcomes that is deemed to encompass claimed steps especially with respect to receiving input and generating an outcome or combining outcome and determining a payout based on the symbols or determining an outcome at a device determining an association and outputting an indication, as particularly claimed. Also, it would have been obvious to an artisan to cancel steps/features such as aspects regarding formation of team or determination of what constitutes a bonus from Walker where patentability does not lie therein so as to secure a broader form of invention.

Claim Rejections - 35 USC § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

10. Claims 15-16 and 35-37 are rejected under 35 U.S.C. 102(b) as being anticipated by Piechowiak (5580309). As best understood with broadest reasonable interpretation of claim language, Piechowiak discloses a method teaching receiving a first input at a first gaming device 101, receiving a second input at a second gaming device 102, generating an outcome comprising indicia (3:5-12, 22-36, 65), the outcome comprises a plurality of symbols, the symbols derived from the reels of the first and second gaming devices (3:10-13, 22-25), determining an outcome of a game by playing a first device (101), determining a second player associated with first player (102), outputting an indication of the outcome obtained (sic), wherein the playing the first device at substantially the same time at which playing the second device (sic), first and second device in communication

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with a controller and the controller determines outcome has been obtained and in response causes output the indication via the display (supra).

Allowable Subject Matter

11. Claims 33-34 and 37 appear to contain allowable subject matter.

Conclusion

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to M. A. Sager whose telephone number is 571-272-4454. The examiner can normally be reached on T-F, 0700-1730 hours.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's acting supervisor, John Hotaling can be reached on 571-272-7147. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.



M. A. Sager
Primary Examiner
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